

Application No. 09/835,673  
Amendment dated October 23, 2003  
Reply to Office Action of July 23, 2003

## **REMARKS**

Claims 1-12, and 15-30 are pending in the application. The Examiner has rejected Claims 1-14 and allowed Claims 15-30. Claims 13 and 14 are cancelled without prejudice by the current amendment.

### **Claim Rejections – 35 U.S.C. §112**

Applicants have amended Claim 1 to obviate the Examiner's 35 U.S.C. §112, second paragraph, rejection of Claims 1-7.

### **Claim Rejections – 35 U.S.C. §102**

The Examiner rejected Independent Claim 8 and Claims 9 and 11 depending therefrom under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,095,810 (hereinafter "Bianchetti '810").

Independent Claim 8 calls for, *inter alia*, excavation means for *excavating* a portion of carious material occupying a portion of a tooth. In rejecting Claims 8, 9 and 11, the Examiner argued that Bianchetti '810 disclosed excavation means 10.

The M.P.E.P. mandates that "the words of [a] claim must be given their plain meaning unless applicant has provided a clear definition in the specification." M.P.E.P. Section 2111.01, citing In re Zletz, 893 F.2d 319, 321, 13 U.S.P.Q.2d. 1320, 1322 (Fed. Cir. 1989). "When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art." Id., citing In re Sneed, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983). "It has been long recognized in our precedent and in the precedent of our predecessor court, the Court of Customs and Patent Appeals, that dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." Texas Digital Systems, Inc., v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002). Applicant respectfully submits that "excavating" as used in the claims of the current application has a plain meaning which defines a function that is not met by hooked to work piece 10 of

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Bianchetti '810. "Excavating" is defined as "1) to make a hole or cavity end, as by digging; hollow out, 2) to form by hollowing out; dig [to excavate a tunnel], 3) to uncover or expose by digging; unearth [to excavate ancient ruins], 4) to dig out", WEBSTER'S NEW WORLD COLLEGE DICTIONARY, p. 495 (4th Ed. 1999).

The entire disclosure of Bianchetti '810 makes clear that the workpiece disclosed therein is utilized only to remove tartar and plaque from the tooth *surface*. See U.S. Patent No. 6,095,810, Abstract ("A workpiece (10) which effect removal of tartar and plaque from the tooth *surface*"); column 1, lines 9-11 ("The invention refers in particular to a surgical instrument employed by dentists for scaling and removing tartar and plaque from the tooth *surface*"); column 1, lines 20-23, column 2, lines 59-61 ("Plaque is a deposit of bacteria that forms through lack of hygiene or disease of the oral cavity; if it is not removed plaque creates the formation of tartar which is a calculus that forms on the tooth *surface*...hooked workpiece 10, which by entering into vibration, carries out removal of the tartar and plaque from the patient's teeth.") (Emphasis added). During a telephone interview of May 12, 2003, Applicants offered to submit a Declaration under 37 C.F.R. §1.132 indicating that the workpiece of Bianchetti '810 while possibly being capable of scratching or roughening the surface of a tooth would be incapable of excavating carious tooth substance as would the excavation means of Independent Claim 8. The Examiner indicated no such Declaration under 37 C.F.R. §1.132 would be necessary and agreed that Bianchetti '801 does not disclose excavating means as called for in Independent Claim 8, and Claims 9, and 11 depending therefrom. Applicants stand ready to submit a Declaration under 37 C.F.R. §1.132 indicating that the workpiece of Bianchetti '810 would be incapable of excavating carious tooth substance as would the excavation means of Independent Claim 8, should the Examiner now wish for such a Declaration to be submitted. Because Bianchetti '801 does not disclose excavation means as called for in Independent Claim 8, and Claims 9 and 11 depending therefrom, Applicants respectfully request withdrawal of the 35 U.S.C. §102(e) rejection of these claims over Bianchetti '810.

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**Claim Rejections – 35 U.S.C. §103**

The Examiner rejected Claims 1, 2 and 4-12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,642,738 (hereinafter "Meller '738") in view of Bianchetti '810.

As indicated above, Bianchetti '810 is directed to a method and apparatus for removing tartar and plaque from the *surface* of a tooth. Therefore, a person of ordinary skill in the art would not be motivated to combine the diagnostic features of the Bianchetti apparatus with the apparatus of Meller because the Meller apparatus is a dental drill which is not an appropriate instrument to use in removing plaque or calculus from the surface of the tooth, which is the goal of Bianchetti '810. Because there is no teaching, suggestion, or motivation to combine Meller '738 with Bianchetti '810, Applicants respectfully request withdrawal of the 35 U.S.C. §103 rejection of Claims 1, 2, and 4-12.

Claim 3 depends from Independent Claim 1 and is allowable therewith.

While Applicants disagree with the Examiner's rejection of Claims 13 and 14, these claims have been cancelled without prejudice to expedite prosecution of this application.

**Allowable Subject Matter**

Applicants appreciate the Examiner's allowance of Claims 15-30.

**Interview With Examiner**

Applicants appreciate the Examiner's indication that he will telephone the undersigned to discuss this Amendment after reviewing the same. Applicants look forward to discussing this matter with the Examiner.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically Applicants respectfully submit that the application is in condition for allowance and such action is earnestly solicited.

In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition and authorize that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

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If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 219/424-8000.

Respectfully submitted,

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October 23, 2003  
DATE